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REMARKS

Claims 1-21 are pending in the present application.

In the Office Action mailed April 5, 2006, the Examiner rejected claims 1, 16, 20 and 21 under 35 U.S.C. §102(e), as being anticipated by US Pub. 2003/0076801 by Aikawa et al. (hereinafter "Aikawa"). The Examiner rejected claims 2, 3, 12 and 17 under 35 U.S.C. §103(a) as being unpatentable over Aikawa. The Examiner rejected claims 4-6, and 14 under 35 U.S.C. §103(a) as being unpatentable over Aikawa in further view of US Pub. 2004/0100935 by Papageorngiou et al. (hereinafter "Papageorngiou"). The Examiner rejected claim 15 under 35 U.S.C. §103(a) as being unpatentable over Aikawa and further in view of Papageorngiou, further in view of US Pub. 2004/0161020 by Mathew et al. (hereinafter "Mathew"). The Examiner rejected claims 7 and 18 under 35 U.S.C. §103(a) as being unpatentable over Aikawa further in view of Mathew. The Examiner rejected claim 19 under 35 U.S.C. §103(a) as being unpatentable over Aikawa, and Mathew, further in view of Papageorngiou. The Examiner rejected claims 8-11 under 35 U.S.C. §103(a) as being unpatentable over Aikawa, further in view of Mathew and US Pub. 2003/0086512 by Rick et al (hereinafter "Rick"). The Examiner rejected claim 13 under 35 U.S.C. §103(a) as being unpatentable over Aikawa, and further in view of US Pub. 2004/0196893 by Oh et al. (hereinafter "Oh").

Applicants respectfully respond to this Office Action.

35 U.S.C. §102

The standard for anticipation under §102 requires "the presence in a single prior art disclosure of all elements of a claimed invention arranged as in that claim." *Carella v. Starlight Archery & Pro Line Co.*, 804 F.2d 135, 138, 231 U.S.P.Q.D (BNA) 644, 646 (Fed. Cir. 1998) (*quoting Panduit Corp. v. Dennison Mfg. Co.*, 774 F.2d 1082, 1101, 227 U.S.P.Q. (BNA) 337, 350 (Fed. Cir. 1985)) (*additional citations omitted*). As before, the Examiner has failed to identify each and every claim limitation, and has therefore failed to set forth a prima facie case for anticipation as required by §102.

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In response to Applicants' argument with respect to claims 1, 16, 20, and 21, the Examiner reiterates virtually verbatim the prior rejection without specifying where each of the claim limitations are to be found in the references. The Examiner's rejection is non-responsive to the arguments regarding to the previous version of the claims, and completely ignores the newly added claim amendments. Without changing a single citation from the prior rejection, the Examiner argues that "previously known" stored offsets or energy indicators are also taught by Aikawa. Unfortunately, Aikawa is silent as to this limitation, both in the previously cited portions of the reference, and in the entire reference itself. The Examiner has passed on the opportunity to provide the requisite feedback to move the case to completion.

As further evidence, consider the Examiner's own argument with respect to claims 2 and 17: "Aikawa does not expressly teach storing scrambling code identifiers and associated offsets". This directly contradicts the Examiner's contention that Aikawa teaches "comparing the previously known stored offset ... with the offset of search result from the first plurality of search results ...". Since Claims 1, 16, 20, and 21 all require comparing a stored offset with the offset of one of the plurality of search results, Aikawa cannot form the basis of a proper §102 rejection.

35 U.S.C. §103

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation of, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference(s) must teach or suggest all the claim limitations.

For each §103(a) rejection in this Office Action, Applicants reiterate: the prior art of record does not provide a suggestion or motivation to modify the reference, there is not a reasonable expectation of success, and the reference does not teach or suggest all the claim limitations.

With regard to claims 2 and 17, rather than providing the requested affidavit to support his conclusions about what is known in the art, the Examiner opts to provide three references

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purporting to show that "scrambling code identifiers could be stored in a type of memory for further processing" (Shiu, Lim, and Hokao). Unfortunately, the Examiner fails to point out with any particularity where in any of the three references the limitations could be found, nor provides any motivation to combine the references, nor any evidence that the references alone, or in combination with any of the other cited art would teach the limitations of the pending claims.

With respect to Claim 13, Oh does not teach of comparing one offset with another, and determining if one is within a pre-determined threshold of the other. Rather, Oh teaches of a variable power threshold for comparing with power measurements. Thus, the threshold described in Oh is inapplicable to the claim limitations in the present application, as is the Examiner's argument: "One of ordinary skill in the art would clearly recognize that as the average noise power increases the time lapsed increases; and since, the threshold value is proportional to the average noise power level; therefore, the threshold value increases. The threshold value increases as the average noise power increases because the noise level reference indicates that the propagation environment is bad." Claim 13 contains no such limitations. Neither does Oh. However, the Examiner cites Hirade to provide additional support. Applicant notes that Hirade also uses a threshold for comparing with a power level, not for comparing offsets, and so it too is inapplicable.

Furthermore, for each §103 rejection, Examiner has not yet taken the opportunity to provide the motivation for combining references, as required, and as requested by Applicants.

Thus, a prima facie case of obviousness has still not been presented by the Examiner (for additional detail, reference Applicant's previous response of 01/19/06, as well as the prior responses).

Applicants refer again to arguments in the previous amendment, which have not been addressed or overcome by the Examiner's current rejection. Applicant reiterates by reference all of the arguments in the previous response of 01/19/06, with the intent that a substantive response may be forthcoming. Reconsideration is requested. The prior arguments are omitted for the sake of brevity.

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REQUEST FOR ALLOWANCE

In view of the foregoing, Applicant submits that all pending claims in the application are patentable. Accordingly, reconsideration and allowance of this application is earnestly solicited. Should any issues remain unresolved, the Examiner is encouraged to telephone the undersigned at the number provided below.

Respectfully submitted,

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